



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Addr ss: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

TD

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/323,765 06/01/99 SCOTT

M 259.006US1

EXAMINER

HM22/0102

MARK A. LITMAN
MARK A. LITMAN AND ASSOCIATES, P.A.
YORK BUSINESS CENTER, SUITE 205
3209 WEST 76TH ST.
EDINA MN 55435

HAYES, R

ART UNIT

PAPER NUMBER

1647

DATE MAILED:

01/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/323,765

Applicant(s)

Scott et al

Examiner

Robert C. Hayes

Group Art Unit
1647



☒ Responsive to communication(s) filed on Oct 16, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-54 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-54 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1647

DETAILED ACTION

Election/Restriction

1. Applicant's election with traverse of Group I (claims 1-31) in Paper No. 7 is acknowledged. However, because claims 27 and 29-30 require "further comprising transfusing/transplanting... a human", they should have been alternatively restricted into the invention of Group II. The restriction requirement of Paper No. 6 is, therefore, vacated and replaced by the following restriction requirement.
2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-26, 28 & 31, drawn to non-immunogenic compositions, as well as methods of producing such compositions, classified in class 424, subclass 93.7.
 - II. Claims 27, 29-30 & 32-54, drawn to a method of decreasing phagocytosis, rejection of cells or tissue, or decreasing antibody aggregation by introducing a non-immunogenic molecule into a subject, classified in Class 424, subclass 93.1.
3. The inventions are distinct, each from the other because of the following reasons:

Although there are no provisions under the section for "Relationship of Inventions" in M.P.E.P. § 806.05 for inventive groups that are directed to different methods, restriction is deemed to be proper, because these methods appear to constitute patentably distinct inventions for the following reasons:

Art Unit: 1647

Groups I & II are directed to methods of producing non-immunogenic compositions and toward methods of decreasing phagocytosis, rejection of cells or tissue, or decreasing antibody aggregation within a subject. Each of these methods require physically and functionally distinct elements. For example, the method for producing non-immunogenic cell compositions of Group I does not require subjects to be treated, nor assays for detecting decreased antibody reactions, unlike the method of Group II. These inventions are, therefore, patentably distinct, since one is not required for the other.

Because these inventions are distinct for the reasons given above, they have acquired a separate status in the art as shown by their different classification, and the non-coextensiveness of the search and examination for each group would constitute an undue burden on the examiner to search and consider each of these separable groups with their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Art Unit: 1647

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Robert Hayes whose telephone number is (703) 305-3132. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Robert C. Hayes, Ph.D.
December 28, 2000



GARY L. KUNZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600